

In the Restriction Requirement mailed from the PTO on December 4, 2006 ("the Restriction Requirement") in the above-identified application, the Examiner required restriction among six species, identified by figures:

- Species A, detailed by FIG. 1 and page 5, lines 1-15;
- Species B, detailed by FIG. 6 and page 10, lines 8-22;
- Species C, detailed by FIG. 12 and pages 11 and 12, lines 27-29 and 1-9, respectively;
- Species D, detailed by FIG. 13 and page 12, lines 10-13;
- Species E, detailed by FIG. 14 and page 12, lines 14-26; and
- Species F, detailed by FIG. 15 and pages 12 and 13, lines 27-29 and 1-9, respectively.

The Examiner stated that the species are independent or distinct because they are "structurally different from each other" and that "no claim appears to be generic" (Restriction Requirement, page 2). The Examiner further restricted, upon election of one of the above species, among three sub-species:

- Sub-species 1: an intermittent light-transmissive blocking material;
- Sub-species 2: an intermittent conductive light blocking material; and
- Sub-species 3: an intermittent opaque light blocking material.

In the Reply to the Restriction Requirement mailed to the U.S. PTO on February 5, 2007 (the "first Reply"), Applicants amended Claim 1 to indicate that the polarizer is an optical polarizer film comprising a substrate having a subwavelength moth-eye structure including peaks and valleys, and an intermittent surface covering at least a portion of the substrate and providing polarization, and provisionally elected with traverse the species described with respect to FIG. 1 drawn to an optical polarizer film. Applicants indicated that, with the amendment of Claim 1 and its dependent claims remaining for prosecution in the first Reply, Claim 1 was believed to be generic, with amended Claims 1-4, 10-12, 14-23 and 26-27 reading on the elected species and directed to an optical polarizer film.

In response to an Office communication mailed on May 7, 2007 indicating Applicants bona fide attempt to reply omitted further restriction among the sub-species identified in the Restriction Requirement, Applicants mailed to the U.S. PTO on July 5, 2007 a Reply (the "second Reply") provisionally electing with traverse the species identified as Species A described with respect to FIG. 1 drawn to an optical polarizer film and the sub-species identified as sub-species 2 directed to a conductive light blocking material. With the provisional election with traverse of sub-species 2 in the second Reply, Claims 14-23 remain for consideration and are believed to read on the elected species and sub-species.

Applicants traversed the Restriction Requirement on the grounds that the Restriction Requirement is unconventional, difficult to understand, and does not comply with the Manual of Patent Examining Procedure (8<sup>th</sup> Edition, Revised August, 2006; "the MPEP"). Restriction Requirements are made when groups of claims to inventions are found to be either independent or distinct. See MPEP § 806. Applicants indicated the Examiner must point out the reasons why such claim species are considered either independent or distinct (first Reply, page 6). Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the others; and (B) the reasons why there would be a serious burden on the Examiner if restriction is not required, i.e., the reasons for insisting upon restriction therebetween as set forth in the following sections. A mere statement of conclusion is inadequate. See MPEP § 808.

Applicants informed the Examiner that, in particular, the Examiner failed to indicate exactly how the application is to be restricted (first Reply, page 6): "The examiner must provide a clear and detailed record of the restriction requirement to provide a clear demarcation between restricted inventions... In setting for the restriction requirement, separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to a subcombination, or to a product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass." MPEP § 814. Section 817 of the MPEP presents an outline to be followed by patent examiners in setting for a restriction requirement.

Applicants cannot recognize the parts of the outline in MPEP § 817 in the Restriction Requirement. Further, the Examiner has not set forth any groups of claims to independent or distinct inventions. Rather, the Examiner has indicated figures illustrating embodiments of the claimed invention. It is therefore believed insufficient for the Examiner to simply refer to certain figures in the application without an indication of which claims belong to which supposed claimed species groups. The Examiner's election requirement is therefore improper and should be withdrawn.

With respect to (A), the Examiner has simply stated that the enumerated Species are structurally different from each other without any analysis supporting this conclusion. No reasoning has been presented. FIG. 1 illustrates a polarizing film utilizing moth-eye structures in accordance with Applicants' invention. FIGS. 12-15 illustrate various additional embodiments using multiple moth-eye structures in accordance with Applicants' invention. "Structural difference" alone is an insufficient reason to find claims are "independent" and "distinct."

With respect to (B), the Examiner has not given any reason why examining all the claims together would be a serious burden for the Examiner. To establish reasons for insisting on restriction, the Examiner must show by appropriate explanation one of the following: (1) separate classification of the inventions; (2) separate status in the art of inventions classified together; or (3) different fields of search for the inventions. See MPEP § 808.02. None of these was shown by the Examiner.

Moreover, it should be noted that the features described in the claims of Species A-F already have been examined by the Office together, as evidenced by the three substantive Office Actions issued in this case. In particular, the Office mailed a Restriction Requirement dated February 10, 2005, an Action dated June 8, 2005, and a Final Action dated March 13, 2006. In each of the previous substantive Actions, the Office examined the claims of Species A-F together. There would be no additional or unusual burden on the Examiner to continue examination as it has been conducted so far in this case.

In response to Applicants' traversal, the Examiner states that the reasons for traversal are not persuasive "because Applicants have identified at least six embodiments" and repeats the demarcation of Species A-F identified in the Restriction Requirement by reference only to FIG. numbers and the corresponding description from the specification without any regard to the

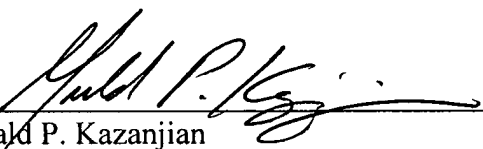
claims. In view of the Examiner's previous five Actions, the recent mailing of this most recent Office Action that maintains the requirement of election is a cause of concern to Applicants regarding the pace of prosecution. Piecemeal examination should be avoided as much as possible. MPEP § 707.07(g).

In view of the foregoing and in the absence of sufficient explanation of the Restriction Requirement and for its justification, Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement in the above-referenced application.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By

  
Gerald P. Kazanjian

Registration No. 61,699

Telephone: (978) 341-0036

Facsimile: (978) 341-0136

Concord, MA 01742-9133

Date: 1/31/08